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In The

Supreme Court of the United States

October Term, 1966

No. 1106

DEMPSTER BROTHERS, INC., et al.,

Petitioners,

vs.

BUFFALO METAL CONTAINER CORPORATION, et al.,

Respondents.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Second Circuit

BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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We oppose the granting of the petition because we maintain:

1. That this Court has not ruled that uncorroborated oral testimony to prove prior art is legally insufficient per se;

2. That even if it has, the question is not squarely presented here since there is corroboration of the oral testimony which is challenged by Petitioners together with proof of other prior art not completely identified or discussed by the courts below;

3. That the decision below is not in conflict with the decisions of this Court nor with decisions of other circuits as to the quantum of proof necessary to establish prior art.

STATEMENT OF FACT

We take emphatic issue with Petitioners' repeated assertion that the Court below found that the C-A loader, the device in question, represents a patentable combination, but that the patent was barred because of certain prior use devices. Petitioners' base their assertion on the following sentences taken from the decision of the Court below (Pet. App. 8a):

> "The C-A model represented a significant improvement over the H-O. Indeed, we do not understand Buffalo to contend that the C-A loader would not have been patentable, had there been no other developments in the field subsequent to 1953."

We hardly consider these sentences a flat finding of patentability. We have not and will not admit patentability of this device since the prior act even in 1953 was such that the improvements claimed in the C-A loader were obvious.

ARGUMENT

POINT I

This Court has not ruled that uncorroborated oral testimony to prove prior art in patent cases is legally insufficient.

Petitioners claim that *Smith v. Hall,* 301 U.S. 216, 222, 57, S. Ct. 711, 714, affirming earlier decisions in *Eibel Process Co. v. Minnesota and Ontario Paper Co.* (1923), 261 U.S. 45, 45 S. Ct. 322; *Deering v. Winona Harvester Works* (1894), 155 U.S. 286, 15 S. Ct. 118; and *The Barbed Wire Patent* (1892) 143 U.S. 275, 12 S. Ct. 443, is authority for the proposition that uncorroborated oral testimony is insufficient in law to prove prior art in patent cases.

We disagree. Beginning with *The Barbed Wire Patent,* supra, these earlier decisions gave warning of the danger of such testimony but did not state that it would be legally insufficient. *The Barbed Wire Patent,* supra, requires proof that is "clear, satisfactory and beyond a reasonable doubt". *Deering v. Winona Harvester Works,* supra, requires that the evidence be "so cogent as to leave no reasonable doubt in the mind of the court that the transaction occurred substantially as stated". In *Eibel Process Co. v. Minnesota and Ontario Paper Co.,* supra, states that "evidence to prove prior discovery must be clear and satisfactory."

In *Smith v. Hall,* supra, the court had reference to specific oral testimony given in *that* case where it stated that "without corroboration, it is insufficient to establish prior use", immediately cited *Barbed Wire, Deering,* and *Eibel* and went on to agree that the very same oral testimony was, after all, amply corroborated. The proposition so earnestly pressed by Petitioners is, therefore, not the law of *Smith v. Hall.*

Moreover, this Court, in *Corona Cord Tire Co. v. Dovan Chemical Corporation* 276 U.S. 358, 381, 382, 48 S. Ct. 380, accepted uncorroborated oral testimony of a single witness who testified as to shipping prior art devices to a customer. The Court pointed out that this witness was not seeking a patent, had no pecuniary interest in the result of the case, and then stated:

> "The fact that he is the only witness is not fatal or any reason for denying the weight of his testimony in connection with other circumstances."

POINT II

There is corroboration of the challenged oral testimony of prior use herein together with proof of other prior art devices.

Even assuming *arguendo* that Petitioners are correct in their interpretation of *Smith v. Hall,* supra, this case does not present the question squarely. Barnes identified a May, 1956 photograph as representative of his January 31, 1956, purchase of his prior art garbage truck. In addition, Barnes produced synchronous purchase and financing documents covering this truck. It is true that the Court below stated that it placed little reliance thereon because of vague descriptions of the device contained therein, but it did not completely ignore these documents. Further, Barnes owned and possessed this device on the day he gave his testimony thereon in open Court (R. 244).

As to the Bowles unit, while neither Court below mentioned it, other documentation besides the photographs were introduced into evidence such as an invoice (R. 273) and a conditional sales contract (R. 299) both contemporaneous with the matters in question. Further, as in the case of the Barnes unit, the prior art device was owned and in the possession of the witness Bowles at the time he gave his testimony thereon in deposition form. As a matter of fact, Bowles' testimony and that of Mick, who originally purchased the unit from Bowles in 1955, was taken at Bowles' office with the truck parked outside in Bowles' yard (R. 268). The witness Mick was taken outside to the truck whereupon he identified it and confirmed the serial number on it as being the same as on the conditional sales contract hereinbefore mentioned (R. 301).

As to the Western Body and Hoist Company devices, the decision below refers only to photographs of one such unit, the truck having the "S"-shaped arms. Other documentation was introduced on this device, including a job sheet. In addition, documented testimony was given on many other Western Body prior art devices including those depicted in the Appendix (Pet. App. 345).

Other evidence of prior art was put into the record which was not challenged by Petitioners but which is not all specifically set forth in the decisions of the two Courts below. Therefore, since there is corroboration of the challenged oral testimony and other prior art, we submit that the question is not squarely presented. This Court has always insisted on a relevant factual record so as to relate its decision thereto. We do not have that here.

POINT III

The decision below is not in conflict with decisions of this Court nor with decisions of other circuits.

As we have heretofore submitted, this Court has never stated that uncorroborated oral testimony as to prior art is legally insufficient per se.

What is clear and convincing evidence in a case must be determined against the context of the patent, the prior art and the particular circumstances of the case. It should not be the prisoner of a formula and is not an absolute to be considered in a vacuum.

A careful reading of each of the cases cited by Petitioners as being in conflict with the decision of the Court below, reveals that the courts in those cases weighed each item of proof in such fashion. The context of the patent, the complexity of the device, creditibility of witnesses, lapse of

time, contradictory evidence and all the other circumstances of the case were taken into consideration in determining whether proof was clear and satisfactory. Each case turned on its own facts.

We cannot find any departure by the Court below from the requirements of proof of prior art as established by this Court, nor can we find any conflict (much less a *real* conflict) between the decision at hand and the decisions of the other circuits.

ON THE MERITS

In view of the Court's recent decision in *Graham v. John Deere Co.* of Kansas City 383 U.S. 1, 86 S. Ct. 684, we need not reply to Petitioners' position on standards of invention and obviousness. Their C-A loader does not measure to the standards required by this Court.

CONCLUSION

The petition for certiorari should be denied.

Respectfully submitted,

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